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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/800,796	03/15/2004	Mark G. O'Donnell	ODonnell.7374	9194

7590 09/27/2004

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EXAMINER

BRINSON, PATRICK F

ART UNIT	PAPER NUMBER
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3752

DATE MAILED: 09/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/800,796	Applicant(s) O'DONNELL ET AL.	
	Examiner Patrick F. Brinson	Art Unit 3752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/1/04 and 7/1/04</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Double Patenting

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2. Claims 1, 2, 10, 11, 20, and 25 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1, 9, 20, and 23 of copending Application No. 10/226,720. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless —

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 5-8, 10-11, 14, 15 and 21 are rejected under 35 U.S.C. 102(b) as

being anticipated by **Conaghan et al.**

The patent to **Conaghan et al.** discloses a protector for protecting elongated articles such as wires, hoses, etc comprising a flexible heat settable material that is heat set into a spiral position along a length of the flexible heat settable material. It is disclosed that the sleeve is formed to a specific desired geometry by wrapping the strip in a helical fashion upon a mandrel of the desired diameter of the ultimate product. Preferably, one side edge of the strip overlies the other side edge as shown in fig. 1. The amount of overlap should range from 10 to 50 percent of the width of the strip when the material is wrapped upon a mandrel. Col. 4, lines 67, 68 and col. 5, lines 1-5 state that although tubular articles having substantially cylindrical cross-section are illustrated in the drawings, other cross sections, such as rectangular, square or triangular may be set into the fabric by the use of dies or mandrels of the desired shape.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 4, 9, 12, 13, 16, 22, 23, 25 and 26 rejected under 35 U.S.C. 103(a) as being unpatentable over **Conaghan et al.**

The patent to **Conaghan et al.** discloses a protector, as discussed in the preceding paragraph, however, it does not specifically disclose the inner diameter nor weight of the protector. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to form the protector having an inner diameter of about 0.8 cm or no more than 2.5 cm, and have a weight of less than 2.5 ounces, because Applicant has not disclosed that these specific dimensions provide an advantage or solves a stated problem. It should also be noted, that where the only difference between the claimed invention and the prior art is a recitation of relative dimensions, wherein the claimed invention would not perform differently than the prior art, the claimed invention is not patentably distinct from the prior art device. Therefore, it would have been an obvious matter of design choice to modify **Conaghan et al.** to obtain the invention as specified in claims 2, 3, 8, 10, 11 and 14. As to the method of use, **Conaghan et al.** discloses that the protective sleeve protects elongated articles such as wires and hoses. Though not specifically disclosing a rope or webbing, it would have been obvious to one of

ordinary skill in the art at the time the invention was made to wrap an elongated piece of rope or webbing, wherein it is known that heat set protectors are utilized in protecting any elongated article.

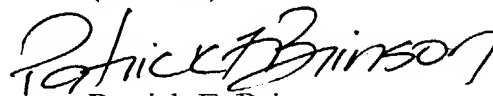
5. Claims 17-20 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Conaghan et al.** in view of **Whittington**.

The patent to **Conaghan et al.** does not disclose the protector as being formed of a urethane. The patent to **Whittington** discloses a protective wrapping for an elongated member, wherein col. 3, lines 28 and 29 disclose that one suitable material for the wrapping is urethane rubber. This wrapping, once placed in a mold or on a mandrel is subjected to heat and pressure to cure or vulcanize the rubber layers, thus producing a wrapping having great resistance to radially outward deformation, and providing cushioning and protection from outside wear and abuse. It would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute for the material of **Conaghan et al.** a urethane as suggested by **Whittington** in order to produce a protector that will provide a cushioning for the protected member, and prevent wear and abuse.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Patrick F. Brinson** whose telephone number is (703) 308-0111. The examiner can normally be reached on M-F 7:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Michael Y. Mar** can be reached on (703) 308-2087. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Patrick F. Brinson
Primary Examiner
Art Unit 3752

P. F. Brinson
September 24, 2004